Appln. No.: 10/661,886
Amendment Dated August 16, 2011
RCE Filed August 16, 2011

D&Q-100US1

Remarks/Arguments:

This Amendment is filed pursuant to a Request for Continued Examination filed to expedite prosecution, clarify the language of the claims, and re-initiate a dialogue with the Examiner regarding examination of the claims, thereby withdrawing the pending Appeal. Claims 1-43 have been canceled without prejudice. Applicants respectfully submit that new claims 44-69 are patentable over the cited art for the reasons discussed herein.

Jacoves

The prior pending claims were rejected based upon Jacoves (U.S. Pub. App. No. 2001/0018664). Each of the pending independent claims (44 and 56) now recites a system (claim 56) comprising "a user interface configured to permit direct purchaser submission of the rebate claim via a communications network" or the method step (claim 44) of providing such a user interface. Applicants expressly define the "rebate claim" in the new claims as "comprising a submission that includes at least the unique transaction identifier in association with information identifying the purchaser." The new claims also contain a temporal limitation with respect to processing of the rebate claim. The claimed temporal limitation is expressed in method claim 44 as:

> . . . **after receipt of the rebate claim**, comparing with the rebate computer processing system the product code for each promoted product purchased in the identified transaction against the information relating to one or more promotional offers, and determining the collective value associated with any promotional offers applicable to the one or more promoted products purchased in the identified transaction . . .

The similar limitation is expressed in independent system claim 55 as:

> . . . a rebate computer processor . . . programmed to, **in response to receipt of the rebate claim** . . .compare the product code for each promoted product purchased in the identified transaction against the information relating to one or more promotional offers, and . . . determine the collective value associated with any promotional offers applicable to the one or more promoted products purchased in the identified transaction . . .

Thus, to the extent that the Office equates the "UID" disclosed in Jacoves to applicants' claimed unique transaction identifier, applicant respectfully submits that Jacoves fails to teach or suggest comparing the product codes against the promotional offers and determining the collective value associated with the promotional offers **after receipt of the UID**, as recited (in more detail) by Applicants in the claims (hereinafter "the comparing and determining steps"). Similarly, Jacoves fails to teach or suggest a system programmed to execute the comparing and determining steps **in response to receipt of** the rebate claim. While Jacoves teaches that "each transaction, which results in the generation of a redemption slip 212, has associated therewith a UID," (Jacoves, ¶ 0042) Jacoves expressly teaches that the redemption slip 212:

> . . . contains information as to the discount triggering items that have been purchased, the number thereof, and also the discount associated with each type of product. **A total discount will also be provided in addition to other information.** (Jacoves, ¶0032, emphasis added)

Thus, if the Jacoves scheme provides the UID at the time the redemption slip is created, and the redemption slip includes the "total discount," then the comparing and determining

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steps must occur at the same time that the UID is assigned. Accordingly, Jacoves cannot possibly be construed as teaching or suggesting *receiving a rebate claim comprising submission of the UID* and *then* carrying out the comparing and determining steps, as Jacoves does not provide the UID to the user until after the comparing and determining steps have been carried out. There is furthermore no teaching or suggestion to modify the Jacoves scheme to include this temporal limitation.

Applicants further note that in the alternate embodiment described by Jacoves, in which a purchaser of gasoline manually enters a four-digit code corresponding to "a particular unit of accumulated credit discounts," (Jacoves, ¶ 0045) this embodiment again requires that the comparing and determining steps be carried out prior to the purchaser being assigned the code. Again, the Jacoves scheme requires carrying out the comparing and determining steps at the time the code is generated, not at the time it is received for redemption. In the Jacoves scheme, *as with any coupon method*, it is important for the discount to be readily available to the consumer, making it impractical to modify the Jacoves scheme to carry out the comparing and determining steps only after receipt of the code as claimed by Applicants, as is further discussed below.

One of skill in the art would not be motivated to modify the Jacoves system (which is a coupon scheme rather than a rebate scheme) to incorporate Applicants' claimed temporal limitation relating to the comparing and determining steps, because of many disadvantages of waiting until a coupon redemption event to process the amount of the discount. First of all, the user would not necessarily know the value of the coupon prior to redeeming it, which would take away the incentive of using it (consider how much incentive is provided to a consumer to patronize a particular gas station knowing he has a coupon worth $10, versus a coupon of unknown value). In fact, in the commercial embodiment of the Jacoves technology currently being used by Giant supermarkets and Shell gasoline stations, the supermarket cashiers tell the customer, for example, that the customer has earned "30 cents off a gallon of gas" or that they are "$3 from earning 40 cents off a gallon of gas" as they hand the customer the grocery store receipt. This reinforces in the consumer's mind the amount of discount earned that will be applied if the consumer purchases gas before the discount expires, and it further encourages the consumer to come back and purchase more at the grocery store before the next time he or she fills the gas tank. These incentives are at the core of the Jacoves technology, and one of skill in the art would have no motivation to modify Jacoves to take away such incentives.

Secondly, the Jacoves system could not tolerate the risk of system failure or delay inherent in a method that requires performing the complex calculations and retrievals associated with the comparing and determining steps at redemption. The gas station redeeming Jacoves' coupon discount does not want a long line of cars waiting to pump gas or finalize transactions for gas already pumped, because the coupon calculation system has stalled calculating the amount of discount to apply. Accordingly, it is important in the Jacoves system for the amount of the coupon discount to be determined prior to redemption. This need for knowing the prior coupon amount is particularly acute in the embodiment that requires the consumer to hand the gas station attendant the slip showing the amount of the discount. Knowing the amount of the discount prior to redemption is also consistent with the general nature of a coupon. Therefore, not only is there no motivation to modify Jacoves to arrive at the claimed invention, but furthermore, combining Jacoves with other references fails to teach or suggest Applicants' claimed invention. In summary, the advantages of knowing the value of a coupon removes all motivation for one of skill in the art to modify Jacoves to incorporate the delay inherent in Applicants' claimed feature of performing the comparing and determining steps only after receipt of the rebate claim.

By contrast, Applicant's claimed methods and systems, which are true **rebate** methods and systems, experience no disadvantages by waiting to calculate the value of the rebate until after the rebate claim is submitted. In fact, a delay in processing ensures that resources are committed to determining the amount of the rebate only after there is certainty that the rebate will be claimed. As is well known, a large percentage of consumers never claim rebates earned, so delaying the calculating and determining steps until redemption means no resources are expended calculating rebates that are never redeemed. While systems which perform the comparing and determining steps prior to receipt of the rebate claim are within the scope of other embodiments of Applicants' invention, the specific inventions recited in this application do not claim such embodiments.
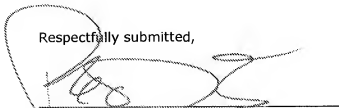
Applicants' Claimed Invention Does not Require Subsequent Purchase

Claims 54 and 68 recite that "the collective value provided to the purchaser does not require a subsequent purchase by the purchaser to realize the collective value" and likewise, claims 55 and 69 recite that "the rebate claim comprises a submission that is not pursuant to a subsequent purchase." Both of these features, inherent in Applicants' methods and systems, are also distinguishing from the Jacoves system, which necessarily requires a subsequent purchase to realize the value of the coupon discount and in which that purchase serves as the claim for the discount earned. Consumers enjoying Applicants' claimed method do not require a subsequent purchase to realize the value that has been accumulated, and the rebate claim is an independent act that is not in the nature of making a subsequent purchase, as is supported throughout the disclosure. The requirement to make a subsequent purchase (which also serves as the claim for the discount earned) is core to the Jacoves system of earning points in a grocery store for redemption at a gas station, and therefore, it would defeat one of the primary purposes of the Jacoves system to modify it to omit this essential teaching.

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Summary

       For all of the above reasons, Applicants therefore respectfully submit that the new claims submitted herewith are patentable over the cited references. The pending dependent claims are allowable at least for the reasons discussed above, as well as for additional reasons consistent with the specific recitations of the claims, none of which are discussed in detail at this time for brevity and efficiency, but any of which the Applicants' attorney will be pleased to discuss with the Examiner pursuant to an in-person or telephonic interview.

Respectfully submitted,

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Dated: August 16, 2011

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